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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,089

03/19/2004

Ulrich Orth

66489-036-8

7897

25269

7590

07/21/2006

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EXAMINER

WERNER, JONATHAN S

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/804,089	Applicant(s) ORTH ET AL.	
	Examiner Jonathan Werner	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/11/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/19/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group 1, claims 1-17 in the reply filed on 5/11/06 is acknowledged. Applicant has failed to specify what ground(s) the traversal is on. Accordingly, this is not found persuasive. The requirement is still deemed proper and is therefore made FINAL.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 3/21/03. It is noted, however, that applicant has not filed a certified copy of the 10312848.4 application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 3/19/04 is noted. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4-5, 7-8, 10 and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

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subject matter which applicant regards as the invention. As to claims 4-5 and 7-8, it is not clear how a database can comprise a "materialized" structure. Claim 10 recites the limitation "the premises." There is insufficient antecedent basis for this limitation in the claim. In re claim 12, Applicant claims "display means and a monitor" as examples of the input unit, however, said items are representative of an output unit. Claim 13 recites the limitation "display unit." There is insufficient antecedent basis for this limitation in the claim. Additionally, claims 13-14 each claim an input unit and a display unit, and wherein since both claims are dependent on claim 12 which is a Markush-type claim, said "display means [unit]" does not necessarily have to be chosen from claim 12 and hence lacks antecedent basis in claims 13 and 14. In re claim 15, it is not clear where the exchange of data is from. For the purpose of examination, examiner will understand the claim to mean an exchange of data between an operating system and display terminal.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-14, 17-18 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Farag et al. (US 2002/0028418). In re claim 1, Farag discloses the use of a database for the storage of data (paragraph 0038), said database comprising

dental data concerning dentition-specific and tooth-specific features wherein the data illustrate real teeth as images in digitized form (paragraph 0038) and said digitized form involves dentition-specific and tooth-specific features including tooth family-specific characteristics (123, Figure 8). As to claim 2, the dental data are associated with an actual person (paragraph 0038). As to claims 3 and 6, the dentition-specific and tooth-specific features comprise data representing number, position, character, and anomalies of teeth and their cooperation with each other (123, Figure 8). In re claims 4-5 and 7-8, Farag discloses producing a physical cast of the dentition-specific structure that is individualized to the patient (paragraph 0037). As to claim 9, additional data can be stored relating to dental design features (paragraph 0093). As to claim 10, the database is located directly on the premises (124, Figure 1) and can also be situated any place in the world and accessed by telecommunication means (paragraphs 0025/0029). As to claim 11, the database is equipped with an input unit and (116) an output unit (112). As to claim 12, the input unit is a keyboard. As to claim 13, the database is accessible by a user with the aid of input and display unit (paragraph 0027). As to claim 14, a computer program supports interaction between the input unit, display unit, and database (paragraphs 0026/0027). As to claims 17 and 18, the data of the database is used to construct a tooth model (paragraph 0095) and wherein the tooth model includes an outer surface specified by means of the data, wherein the data used for this purpose is taken from the database. In re claim 26, the database is used in a method (300) of conceiving the tooth model whose external shape is constructed from the data, said method comprising taking data from the data base and forming an image

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of a tooth model on display means (Figure 8), and with help of the image, input, and output devices, producing the model (Figure 3). Examiner notes that Applicant does not positively claim a method of conceiving the tooth model. As a result, the content of the claim is considered as functional language, whereby statements of intended use and other functional statements do not impose any structural limitations on the claims distinguishable over the prior art of record. Similarly, Examiner notes that claims 13 and 15 are predominantly recitations of functional language and hence the examination of which follows the same guidelines outlined above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farag in view of Paiz (US 2001/0037304). In re claim 15, Farag discloses the database as previously described, but fails to disclose an exchange of data between the user and the operating terminal is only possible with the aid of a payment system. Paiz, however, teaches providing data to a user through a computer network system in exchange for payment (claim 11). Therefore, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to make the exchange of data only possible with the aid of a payment system in order to control user access and collect payment for said access as taught by Paiz. As to claim 16, Farag discloses the computer program synthesizes new data from selected data (paragraph 0031).

Conclusion

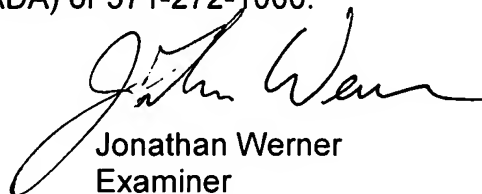
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to included form PTO-892 for all additional pertinent prior art related to databases and tooth models.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Werner whose telephone number is (571) 272-2767. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jonathan Werner
Examiner
TC 3700

7/17/06



CRIS L. RODRIGUEZ
PRIMARY EXAMINER